AUS920010777US1

REMARKS

Claims 1-15 are in the case. Claims 1, 6, and 11 stand rejected under 35 U.S.C § 102(e) as being anticipated by Morris (U.S. Patent No. 6,353,848). Claims 2-5, 7-10, and 12-15 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Morris in view of Yamada *et al* (U.S. Publication No. 2002/005291).

Claim Rejections – 35 U.S.C. §102 Over Morris

Claims 1, 6, and 11 stand rejected under 35 U.S.C § 102(e) as being anticipated by Morris (U.S. Patent No. 6,353,848). To anticipate claims 1, 6, and 11 under 35 U.S.C. § 102(e), two basic requirements must be met. The first requirement of anticipation is that Morris must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that Morris must enable Applicants' claims. Morris does not meet either requirement and therefore does not anticipate Applicants' claims.

Morris Does Not Disclose Each and Every
Element of Applicants' Claims 1, 6, and 11

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Morris does not disclose each and every element of claim 1. Independent claim 1 claims:

> A method of control of collaborative devices, the method comprising the steps of:
>
> providing at least two collaborative devices, wherein each collaborative device comprises a client device and an embedded Java server;
>
> providing a registry service to which the collaborative devices are coupled for data communications;

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providing at least one registry table, wherein the registry table further comprises registry records, wherein the registry records comprise registry records representing capabilities of collaborative devices, wherein the registry records representing capabilities of collaborative devices further comprise data elements describing, for each collaborative device, capabilities, tertiary relationships, and network connectivities;

providing a service bundle of OSGI-compliant Java servlets comprising at least one predetermined algorithm for controlling the collaborative devices; and

controlling the collaborative devices in accordance with the predetermined algorithm.

The Office Action rejects claim 1, stating that Morris at column 2, lines 45-50 and lines 54-62, discloses "providing at least two collaborative devices ... [each] comprising an embedded Java server." That portion of Morris discloses background material. The background material at column 2, lines 45-50, actually discloses the CU-SeeMe videoconferencing system in which a software application runs on a local user's personal computer and a remote user's personal computer. A software application is not an embedded Java server within the meaning of claim 1. In fact, nowhere in Morris, including the discussion of CU-SeeMe, is there a mention of an embedded Java server. Morris therefore fails to disclose "providing at least two collaborative devices ... [each] comprising an embedded Java server" within the meaning of claim 1. As such, Morris does not disclose each and every element of claim 1. Claim 1 is patentable and should be allowed.

The Office action also states that column 11, lines 63-67, column 11, lines 35-45, and column 11, lines 48-50, of Morris disclose "registry records ... describing, for each collaborative device, capabilities, tertiary relationships, and network connectivities." Morris discloses a method and system for remotely accessing a digital image capture unit, such as a camera. Morris, column 7, lines 2-4. Column 11, lines 35-45, of Morris

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actually disclose storing registration information, such as the name of a camera and associated security information and account information. Column 11, lines 48-50, of Morris also actually disclose maintaining the registration information after a connection is terminated. Column 11, lines 63-67, of Morris actually disclose transmitting instructions to a web server for obtaining images from a camera despite the lack of an open connection between the camera and the web server. The records in Morris are not "registry records ... describing, for each collaborative device, capabilities, tertiary relationships, and network connectivities" as claimed in claim 1. The records in Morris pertain to a single device, the camera, not to multiple collaborative devices. Further, the records of Morris describe the name of the device and security information and account information about the device, not "capabilities, tertiary relationships, and network connectivities" within the meaning of claim 1. As such, Morris does not disclose each and every element of claim 1. Claim 1 is patentable and should be allowed.

The Office Action also states that column 7, lines 21-26, of Morris disclose a "service bundle of OSGI-compliant Java servlets." Column 7, lines 21-26, of Morris actually disclose a single executable program which can be implemented as a Java servlet or a CGI binary or similar program. A single servlet is not a service bundle of OSGI-compliant servlets. Morris therefore does not disclose each and every element of claim 1. Claim 1 is patentable and the rejection should be withdrawn.

Claims 6 and 11 are system and computer program product claims with limitations similar to those of claim 1, including "at least two collaborative devices, wherein each collaborative device comprises a client device and an embedded Java server," "registry records ... describing, for each collaborative device, capabilities, tertiary relationships, and network connectivities," and "a service bundle of OSGI-compliant Java servlets." As stated above, the CU-SeeMe system discussed in Morris actually discloses a videoconferencing system in which a software application runs on a local user's personal computer and a remote user's personal computer. Morris discloses a method and system for remotely accessing a digital image capture unit. Morris therefore fails to disclose "at least two collaborative devices, wherein each collaborative device comprises a client

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device and an embedded Java server;" "registry records ... describing, for each collaborative device, capabilities, tertiary relationships, and network connectivities;" and "a service bundle of OSGI-compliant Java servlets." As such, independent claims 6 and 11 are not anticipated by Morris and therefore should be allowed.

Morris Does Not Enable Applicants' Claims 1, 6, and 11

Not only must Morris disclose each and every element of claim 1 of the present invention within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also Morris must be an enabling disclosure of Applicants' claim 1 within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the applicant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Morris places Applicants' claim 1 in the possession of a person of ordinary skill in the art, Morris is legally insufficient to anticipate Applicants' claim 1 under 35 USC 102(e). Morris in fact does not place each and every element of claim 1 in the possession of a person of skill in the art. Claim 1 is therefore patentable and should be allowed.

Independent claim 1 claims:

> A method of control of collaborative devices, the method comprising the steps of:
>
> providing at least two collaborative devices, wherein each collaborative device comprises a client device and an embedded Java server;

providing a registry service to which the collaborative devices are coupled for
data communications;

providing at least one registry table, wherein the registry table further comprises
registry records, wherein the registry records comprise registry records
representing capabilities of collaborative devices, wherein the registry records
representing capabilities of collaborative devices further comprise data elements
describing, for each collaborative device, capabilities, tertiary relationships, and
network connectivities;

providing a service bundle of OSGI-compliant Java servlets comprising at least
one predetermined algorithm for controlling the collaborative devices; and

controlling the collaborative devices in accordance with the predetermined
algorithm.

The Office Action rejects claim 1, stating that Morris at column 2, lines 45-50 and lines
54-62, discloses "providing at least two collaborative devices ... [each] comprising an
embedded Java server." That portion of Morris discloses background material. The
background material at column 2, lines 45-50, actually discloses the CU-SeeMe
videoconferencing system in which a software application runs on a local user's personal
computer and a remote user's personal computer. A software application is not an
embedded Java server within the meaning of claim 1. In fact, nowhere in Morris,
including the discussion of CU-SeeMe, is there a mention of an embedded Java server.
Morris therefore fails to place one of skill in the art in possession of "providing at least
two collaborative devices ... [each] comprising an embedded Java server" within the
meaning of claim 1. As such, Morris does not enable claim 1. Claim 1 is patentable and
should be allowed.

The Office action also states that column 11, lines 63-67, column 11, lines 35-45, and
column 11, lines 48-50, of Morris disclose "registry records ... describing, for each

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collaborative device, capabilities, tertiary relationships, and network connectivities." Morris discloses a method and system for remotely accessing a digital image capture unit, such as a camera. Column 11, lines 35-45, of Morris actually disclose storing registration information, such as the name of a camera and associated security information and account information. Column 11, lines 48-50, of Morris also disclose maintaining the registration information after a connection is terminated. Column 11, lines 63-67, of Morris disclose transmitting instructions to a web server for obtaining images from a camera despite the lack of an open connection between the camera and the web server. The records in Morris are not "registry records ... describing, for each collaborative device, capabilities, tertiary relationships, and network connectivities" as claimed in claim 1. The records in Morris pertain to a single device, the camera, not to multiple collaborative devices. Further, the records of Morris describe the name of the device and security information and account information about the device, not "capabilities, tertiary relationships, and network connectivities" within the meaning of claim 1. Therefore, Morris does not place one of skill in the art in possession of "capabilities, tertiary relationships, and network connectivities" within the meaning of claim 1. As such, Morris does not enable claim 1. Claim 1 is patentable and should be allowed.

The Office Action also states that column 7, lines 21-26 of Morris disclose a "service bundle of OSGI-compliant Java servlets." Column 7, lines 21-26 of Morris actually disclose a single executable program which can be implemented as a Java servlet or a CGI binary or similar program. A single servlet is not a service bundle of OSGI-compliant servlets. Morris therefore does not place one of skill in the art in possession of a service bundle of OSGI-compliant servlets. As such, Morris does not enable claim 1. Claim 1 is patentable and the rejection should be withdrawn.

Claims 6 and 11 are system and computer program product claims with limitations similar to those of claim 1, including "at least two collaborative devices, wherein each collaborative device comprises a client device and an embedded Java server", "registry records ... describing, for each collaborative device, capabilities, tertiary relationships, and network connectivities," and "a service bundle of OSGI-compliant Java servlets."

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As stated above, the CU-SeeMe system discussed in Morris actually discloses a
videoconferencing system in which a software application runs on a local user's personal
computer and a remote user's personal computer. Morris discloses a method and system
for remotely accessing a digital image capture unit. Morris therefore fails to place in
possession of one of skill in the art "at least two collaborative devices, wherein each
collaborative device comprises a client device and an embedded Java server;" "registry
records ... describing, for each collaborative device, capabilities, tertiary relationships,
and network connectivities;" and "a service bundle of OSGI-compliant Java servlets." As
such, independent claims 6 and 11 are not enabled by Morris and therefore should be
allowed.

Claim Rejections - 35 U.S.C. § 103

Claims 2-5, 7-10, and 12-15 stand rejected under 35 U.S.C § 103(a) as unpatentable over
Morris (U.S. Patent No. 6,353,848) in view of Yamada et al. (U.S. Publication No.
2002/0052913). Applicants respectfully traverse each rejection. To establish a prima
facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining
Procedure* § 2142. The first element of a prima facie case of obviousness under 35
U.S.C. § 103 is that there must be a suggestion or motivation to combine the references.
In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second
element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be
a reasonable expectation of success in the proposed combination of the references. *In re
Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third
element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed
combination of the references must teach or suggest all of Applicants' claim limitations.
In re Royka, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

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The Combination Of Morris And Yamada
Does Not Teach Or Suggest All Of Applicants' Claim Limitations

To establish a prima facie case of obviousness, the proposed combination of Morris and
Yamada must disclose or suggest all of Applicants' claim limitations. Claims 2-5, 7-10,
and 12-15 depend respectively from independent claims 1, 6, and 11. As discussed above
with reference to independent claim 1, Morris discloses a method and system for
remotely accessing a digital image capture unit, such as a camera. Morris fails to
disclose each of the following elements of independent claim 1:

- at least two collaborative devices, wherein each collaborative device comprises a
  client device and an embedded Java server;

      ...

- registry records ... describing, for each collaborative device, capabilities, tertiary
  relationships, and network connectivities; [and]

- a service bundle of OSGI-compliant Java servlets.

Yamada fails to remedy the deficiencies of Morris. Yamada discloses a method and
system for providing information to a user through multiple agents, including a user-
interface agent and domain expert agents. Yamada, Figure 5, paragraph 0123, paragraph
0219, paragraph 0241. Yamada does not disclose "at least two collaborative devices,
wherein each collaborative device comprises a client device and an embedded Java
server." Yamada does not disclose "at least two" "client device[s]." The system in
Yamada comprises at most one client device. The system in Yamada comprises a front,
middle, and back processor. The back processor, when it exists, is a web server, not a
client device. *See, for example,* Yamada, Figures 1-5. The middle processor is either the
same device as the front processor or constitutes a server, not a client device. *Id.* Thus,
the system in Yamada contains only one client device, not "at least two." Furthermore,
there is no mention anywhere in Yamada of an embedded Java server. As such, the

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combination of Morris and Yamada does not disclose each and every element of Applicant's claims.

Yamada also does not disclose "registry records ... describing, for each collaborative device, capabilities, tertiary relationships, and network connectivities." Although Yamada discloses multiple data storage elements, the data stored does not consist of "registry records ... describing, for each collaborative device, capabilities, tertiary relationships, and network connectivities." Instead, Yamada stores information about the user, such as his likes and dislikes; information about communications; and information used to enable the agents, such as image files. Yamada, at paragraphs 0145 (object data), 0150 (conversation data), 0152(dialogue storage data), 0362 (check data storage), 0182 (meta information), 0193 (reference table for keywords), 0176 (personal information database), and 0261 (file of agents indexed by utterances). None of these data storage elements contains information about tertiary relationships or of capabilities of collaborative devices. As such, the combination of Morris and Yamada does not disclose each and every element of Applicant's claims.

Yamada also does not disclose "a service bundle of OSGI-compliant Java servlets." In fact, there is no mention at all in Yamada of "service bundle" or "servlet." Thus, Yamada does not disclose the elements of claim 1 missing from Morris. As such, the combination of Morris and Yamada does not disclose each and every element of Applicant's claims.

Because the combination of Morris and Yamada fails to disclose each and every element of Applicants' claims 2-5, 7-10, and 12-15, the combination of Morris and Yamada cannot support a prima facie case of obviousness, and the rejection should be withdrawn.

<u>No Suggestion or Motivation to Combine Morris and Yamada</u>

To establish a prima facie case of obviousness, there must be a suggestion or motivation to combine Morris and Yamada. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442

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(Fed. Cir. 1991). The suggestion or motivation to combine Morris and Yamada must come from the teaching of either Morris or Yamada themselves, and the Examiner must explicitly point to the teaching within Morris or Yamada suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko,* 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck,* 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman,* 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond,* 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski,* 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action states no rationale for motivation to combine Morris and Yamada other than an assertion at page 5, which states:

> Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Morris and Yamada because they both deal with collaborative devices (e.g. Digital Image Device, and Home appliance) over the network..

> Furthermore, the teaching of Morris based on access a portable digital image over the network combine with Yamada's user support this system, the server, collaborating with the client, interprets the user request and presents to the client information necessary to respond the request will increase efficiency for a client computer to access a digital image over the network..

The Examiner does not cite either Morris or Yamada to support the assertion that combining Morris and Yamada would have been obvious to one skilled in the art. Absent such a showing, the rejection is improper and should be withdrawn.

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<u>No Reasonable Expectation of Success in the</u>
<u>Proposed Combination of Morris and Yamada</u>

To establish a prima facie case of obviousness, there must be a reasonable expectation of
success in the proposed combination of Morris and Yamada. *In re Merck & Co., Inc.*,
800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). As discussed above, Morris
discloses a method and system for remotely accessing a digital image capture unit, such
as a camera. As discussed above, Yamada discloses a method and system for providing
information to a user through multiple agents, including a user-interface agent and
domain expert agents. Yamada, Figure 5, paragraph 0123, paragraph 0219, paragraph
0241. The digital image capture unit of Morris will not work with the multiple agents of
Yamada to control collaborative devices by, for example, "providing at least two
collaborative devices," "providing a registry service to which the collaborative devices
are coupled for data communications," "providing at least one registry table, wherein the
registry table further comprises registry records," "providing a service bundle of OSGI-
compliant Java servlets comprising at least one predetermined algorithm for controlling
the collaborative devices," and "controlling the collaborative devices in accordance with
the predetermined algorithm" as claimed in claim 1 of the present application. There is
therefore no reasonable expectation of success in the proposed combination with respect
to the limitations of claims 2-5, 7-10, and 12-15. The combination of Morris and Yamada
therefore cannot establish a prima facie case of obviousness and the rejection of claims 2-
5, 7-10, and 12-15 should be withdrawn.

<u>Conclusion</u>

Morris does not disclose each and every element of claims 1-15. Morris therefore does
not anticipate claims 1-15. The proposed combination of Morris and Yamada fail to
establish a prima face case of obviousness because the proposed combination does not
disclose each and every element of the rejected claims, there is no suggestion or
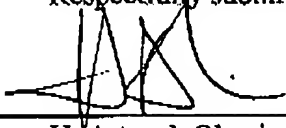motivation to make the proposed combination, and there is no reasonable expectation of

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success in the proposed combination. Applicants respectfully request the allowance of claims 1-15.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Date:___July 25, 2005_____   By: _____

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